

REMARKS

Claims 14-41 are presently pending. Claims 1-13 have been canceled. Claims 14-41 have been added. The specification has been amended to clarify the cross-referencing to related applications.

Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and the remarks appearing below.

Priority

The Examiner has indicated that the present application appears to claim subject matter in various cross-referenced related applications, which Applicant has incorporated by reference. The Examiner then states that if Applicant desires priority under 35 U.S.C. § 120 based upon a previously filed application, specific reference to the earlier filed application must be made in the present application.

Applicant has amended the cross-referencing to related applications to more clearly define the priority claims and cross-referencing being made. As seen, priority is being claimed to each of U.S. Provisional Patent Applications Serial Nos. 60/181,459, 60/181,816, 60/181,741 and 60/181,825, each of which were filed not more than one year prior to the filing date of the present application, with consideration given to the weekend and holiday provisions of 37 C.F.R. § 1.7.

Each of U.S. Patent Applications Serial Nos. 09/781,365, 09/781,368 and 09/781,361 was filed on the same day as the present application. Consequently, a priority claim is not appropriate for each of these applications. However, Applicant cross-references these applications and incorporates them into the present application by reference.

Regarding U.S. Patent Application Serial No. 09/766,456, this application was filed three days prior to the filing date of the present application. Applicant incorporates the subject matter of this application into the present application, as well.

Concerning the need for Applicant to petition the Director for acceptance of the priority claims of the amended specification, Applicant asserts that a petition is not necessary. Applicant believes that the priority claim to the four provisional applications was made in the application as originally filed. Although the manner the claim was made may not have been optimal, ultimately the claim was indeed present.

Regarding the Official Filing Receipt listing only one of the four priority provisional applications, Applicant is presently seeking a corrected Official Filing Receipt that includes a reference to all four of the priority applications.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw the objection to the priority claim.

Rejection under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 1-13 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner states that it is unclear how to make or use Applicant's integrated software system since no structure has been identified.

Without necessarily agreeing with the Examiner's position, Applicant has canceled claims 1-13. Therefore, the present rejection is moot. Consequently, Applicant respectfully requests that the Examiner withdraw the present rejection.

Rejection under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 1-13 under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner cites a number of issues that the Examiner believes renders the claims indefinite.

Without necessarily agreeing with the Examiner's position, Applicant has canceled claims 1-13. Therefore, the present rejection is moot. Consequently, Applicant respectfully requests that the Examiner withdraw the present rejection.

Rejection under 35 U.S.C. § 101

The Examiner has rejected claims 1-13 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. In particular, the Examiner states the claims overlap two different statutory classes of invention.

Without necessarily agreeing with the Examiner's position, Applicant has canceled claims 1-13. Therefore, the present rejection is moot. Consequently, Applicant respectfully requests that the Examiner withdraw the present rejection.

Rejection under 35 U.S.C. § 102

The Examiner has rejected claims 1-6 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0046307 to Rivette et al., stating that Rivette et al. disclose all of the limitations of these claims.

Generally, Applicant respectfully disagrees. However, Applicant has canceled claims 1-6. Therefore, the present rejection is moot. Consequently, Applicant respectfully requests that the Examiner withdraw the present rejection.

Rejection under 35 U.S.C. § 103

The Examiner has rejected claims 7-13 under 35 U.S.C. § 103 as being obvious in view of the Rivette et al. publication mentioned above and U.S. Patent No. 6,298,327 to Hunter et al.

Generally, Applicant respectfully disagrees. However, Applicant has canceled claims 7-13. Therefore, the present rejection is moot. Consequently, Applicant respectfully requests that the Examiner withdraw the present rejection.

Patentability of New Claims 14-33

Applicant asserts that each of new claims 14-41 is patentable over the references of record, including the Rivette et al. publication, alone or in combination with each other and/or ordinary skill in the art.

Regarding the Rivette et al. publication in particular, Rivette et al. disclose therein software that stores in a database a plurality of patents and various types of information relating to these patents. The Rivette et al. software permits a user to track data regarding the stored patents and create relationships among the patents and the corresponding data.

In contrast, new claims 14-19 and 26-31 are directed to methods of processing and presenting data regarding unpatented inventions. Rivette et al. do not so much as suggest providing software for handling unpatented inventions, let alone software that performs the explicit steps recited in new claims 14-19 and 26-31. Therefore, the Rivette et al. publication cannot anticipate these claims.

In addition, Applicant asserts that new claims 14-19 and 26-31 are not obvious in view of the Rivette et al. publication standing alone or in combination with any other references of record and/or ordinary skill in the art. Applicant submits that the concept of analyzing patents and

relating patents with one another and other information is much different from tracking unpatented inventions. One simply does not suggest or obviate the other.

Regarding new claims 20-25 and 32-37, these claims are directed to computer-readable media containing computer-readable instructions for performing the methods of claims 14-19 and 26-31. Since these method claims are patentable over the references of record, so are the corresponding computer-readable media claims.

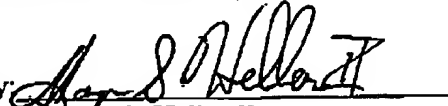
Regarding new claims 38-41, these claims are generally directed to a method and software that allow a user to request an invention report as a function of which stage an invention is in. Since the Rivette et al. software only concerns patents and not inventions generally, any "inventions" disclosed by Rivette et al. could only reasonably be considered to be at one stage, i.e., patented. For this reason, it is Applicant's position that the Rivette et al. software cannot anticipate claims 38-41 and cannot render these claims obvious when combined with other references of record and/or ordinary skill in the art.

For at least the foregoing reasons, Applicant asserts that new claims 14-41 are patentable over the references of record.

Conclusion

In view of the foregoing, Applicant respectfully submits that new claims 14-41, are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

Respectfully submitted,
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